

REMARKS

Claims 1-20 were pending in this Application. Upon entry of this Amendment, Claims 8, 9 and 12-20 will be cancelled. Thus, Claims 1-7, 10 and 11 will remain pending.

The Office Action asserts there is a lack of unity of invention, and has grouped the claims of the present application in to Groups I through XI.

Applicants respectfully traverse.

Applicants note at the outset that this case is proceeding under 35 U.S.C. Section 371, and not 35 U.S.C. Section 111(a), and that therefore the proper analysis is not U.S. Patent Office restriction practice, but is rather the unity of invention standard provided under the Patent Cooperation Treaty regulations, as noted in the Manual of Patent Examining Procedure at Section 1893.03(d).

37 C.F.R. Section 1.499 provides that if an Examiner finds that a national stage lacks unity of invention as set forth in 37 C.F.R. 1.475, the Examiner may require restriction. 37 C.F.R. Section 1.499 also provides that review of any such requirement is provided under 37 C.F.R. Section 1.143 (request for reconsideration) and 1.144 (petition to the Commissioner, noting that a petition will not be considered if reconsideration of the requirement was not requested). Therefore, pursuant to 37 C.F.R. Section 1.143, Applicants hereby request reconsideration of the requirement for restriction.

Applicants note that 37 C.F.R. 1.476 gives the International Searching Authority authorization to make this same determination with regard to unity of invention, and Applicants respectfully but earnestly point out that the International Searching Authority in this case made no objection alleging a lack of unity in this case.

37 C.F.R. Section 1.475 and MPEP Section 1893.03(d) provide that a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one corresponding special technical feature. 37 C.F.R. Section 1.475 provides, and MPEP Section 1890.03(d) repeats, that the expression "special technical feature" is defined as "meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art."

Further, Annex B Part 2 of the PCT Administrative Instructions, as amended July 1, 1992 in Section 206 (appended at AI to the MPEP and cited in MPEP Section 1893.03(d)) provides:

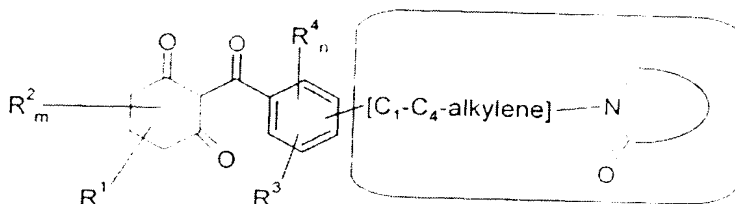
"The determination by the International Searching Authority, the International Preliminary Examining Authority, **and the designated and elected Offices**, whether an international application complies with the requirement of unity of invention under Rule 13 shall be made in accordance with Annex B." Emphasis added.

Applicants again point out for emphasis that the ISA has already made this same determination, a factor which should be given great weight here.

Annex B Part 2 of the PCT Administrative Instructions provides 30 examples concerning unity of invention, with Examples 18-24 providing examples specifically directed to Markush practice. In Example 18, an indolyl moiety provides the significant structural element shared by all alternatives and since all the claimed compounds in Example 18 were alleged to possess the same utility (namely as a pharmaceutical for the purpose of enhancing the capacity of the blood to absorb oxygen) – unity was deemed to be present. Example 20 provides an example of a six-atom **heterocyclic** compound where the compound could include as element "Z" in its six atom ring "oxygen or sulfur" – where unity of invention was deemed to be present.

In light of the ISA's determination in this matter, Applicants believe there is adequate support for the lack of unity objection to be withdrawn. However, as additional support Applicants point out to the Examiner, that there is in fact the same common structure here as is exemplified in the examples of Annex B Part 2 of the PCT Administrative Instructions.

The significant structural element shared by all of the pending claims and qualifying as the special technical feature is:



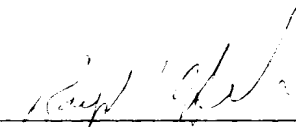
Further, all compounds share a common technical feature, namely their herbicidal activity. The new set of claims are directed to compounds of the formula (I), its method of use and compositions comprising of compound (I). These categories fulfill the requirement of unity.

Applicants, in order to be fully responsive, select as a species, Compound 41.

Reconsideration of the lack of unity objection, withdrawal of the same, and examination of all claims in this one application is respectfully requested.

Respectfully submitted,

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